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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: **John D. Walters**

Appellant: **Nick Bromer**

GAU: **3618**

Title: **DORSIFLEXION SKATE BRAKE**

Serial No.: **09/995,097**

Filed: **Nov. 27, 2001**

This paper: **May 22, 2006**

REINSTATEMENT OF APPEAL AND REQUEST FOR APPEAL CONFERENCE

Mail Stop Non-Fee After Final
Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

This paper responds to the Advisory Action of May 19, 2006. The Examiner states, "The preamble of claim 5 contains open claim language ["comprising"]. Therefore, movements in addition to 'a toe motion consisting ...' are considered to still read on the claim." This assertion is respectfully traversed. Claim 5 reads,

> *For a user having a foot with a toe and standing on a skate, the skate including a position for the foot; a skate braking* ***mechanism*** *comprising:*
>
> *a brake; and*
>
> *a lifter operatively coupled to the brake and pressable upward by a toe* ***motion*** *consisting of an upward rotation of at least one phalanx bone of the toe relative to at least one metatarsal bone of the foot, while the user's foot is on the position, the toe motion acting to actuate the brake ...*

(1) Clearly, the brake and the lifter are two elements of the claimed mechanism. However, a motion cannot be an element of a mechanism. To assert otherwise would be contrary to the PTO's own distinction between method and apparatus. Therefore, "mechanism comprising" in the preamble does not limit the recited motion, because only a mechanism element can be added by "comprising."

If no weight is given to "consisting of" as the Examiner proposes, then the claim would read, *a skate braking mechanism comprising: a brake ... a lifter .. and ... a toe motion.* With respect, that is not a consistent interpretation. "Consisting of" cannot be brushed aside without rendering the claim both senseless and contrary to § 101.

(2) There are two transitional phrases, one nesting inside the other. The Applicant believes that claim construction dictates that the second transitional phrase cover what follows it, rather than to act as if "consisting of" were not even in the claim and let "comprising" run roughshod over all that follows.

(3) MPEP § 2111.03 states, "When the phrase 'consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause." The MPEP does *not* say the phrase "consists of" does ***not*** limit what follows. Indeed, that is believed to be logically contrary to what the MPEP says.

(4) MPEP § 2111.01 states that the claim must be given its "plain meaning" and the plain meaning of the Applicant's claim is what it plainly means, that the motion is restricted to the recited upward rotation. With respect, the Examiner's interpretation is strained.

(5) Furthermore, the Examiner's asserted interpretation is contrary to the Applicant's disclosure and arguments and to the file history.

An Appeal Conference is Requested. The Applicant has already appealed this case and received a decision, but the PTO reopened prosecution. Having already paid the fee for a Notice of Allowance, no additional fee is due because the PTO, not the Applicant, reopened the prosecution. The Applicant hereby reinstates the appeal process and requests a timely appeal conference, well prior to the response deadline of July 21 because the Applicant will be out of the country starting on June 28. The Examiner's cooperation is requested.

The Applicant clearly has novel and potentially very useful subject matter, which the very art applied by the Office (Carlsmith and Integnan) teaches strongly against. An allowance is certainly feasible. What is the problem? The Examiner is invited to telephone the Applicant if any details remain in the way of allowance, and is urged to avoid further pointless delays and wasted efforts by continuing the examination.

Respectfully submitted,

Nick Bromer

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I certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (fax no. 571-273-8300) on May 22, 2006.

Nick Bromer [reg. no. 33,478] *Signature* Nick Bromer

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